

**REMARKS**

Applicants have studied the Office Action dated July 9, 2004 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 17-20, 22, and 24-28 are pending. Claims 1-16, 21, and 23 have been cancelled without prejudice or disclaimer. Claims 17, 19, 20, and 22 are amended and claims 24-28 are new. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1) rejected claims 1-10, 15-18, and 20-23 under 35 U.S.C. § 102(e) as being anticipated by Bahar (U.S. Pub. No. 2002/0019852);
- (2) rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) in view of DiGiorgio et al. (U.S. Pat. No. 6,418,420); and
- (3) rejected claims 11 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) and DiGiorgio et al. (U.S. Pat. No. 6,418,420), in view of Bell (U.S. Pat. No. 6,600,902).

**Telephonic Interview on Friday, September 3, 2004**

As an initial matter, the Applicants wish to thank Examiner Sherkat for the telephonic interview on Friday September 3, 2004. Discussed was the difference between **identification** of a user as contrasted with **authentication** of a user. The present invention as claimed recites **identification of a party accessing the document** and has been further clarified to recite **without authentication**. Accordingly, any user or person in the present invention can pickup a document at a print system as long as the user is identified. This is analogous to a FedEx package being delivered to a mailing address. As long as a person at the mailing address identifies himself or herself, the FedEx delivery person leaves the package. In contrast, the authentication of a user

requires "The verification of the identity of a person."<sup>1</sup> Verification is typically accomplished by matching a previous stored value such as a username and password. The present invention eliminates this step. The present invention provides an audit trail of persons printing a document.

(1) Rejection under 35 U.S.C. § 102(e) Bahar

As noted above, the Examiner rejected claims 1-10, 15-18, and 20-23 under 35 U.S.C § 102(e) as being anticipated by Bahar (U.S. Pub. No. 2002/0019852). Claims 1-10, 15, 16, 21, and 23 have been cancelled. Applicants have amended independent claims 17 and 22 for clarity to more clearly and distinctly recite the present invention. Specifically, claims 17 and 22 now more clearly recite that a document is sent to an address of a presentation device and accessed by entering identification data of the user accessing the document and without authenticating the data. Support for this amended language is found in the original specification and claims as filed. See for example page 10, lines 14 and 15 and page 9, lines 21-26. No new matter was added by these amendments.

Submitted with this response is a Declaration under 37 C.F.R. § 1.131, executed by the Applicants of the instant application, and associated evidence, to establish that the invention claimed in the instant application was reduced to writing in the United States prior to December 15, 1999. Thus, the invention claimed in the present application was invented prior to December 15, 1999.

The Bahar reference cited by the Examiner was filed in the U.S. Patent and Trademark Office on October 16, 2001 and claims priority to CIP application No. 09/460,531, filed on December 15, 1999, which is after the date of invention of the invention claimed in the instant application. Accordingly, Bahar is removed as an available prior-art reference and cannot be cited against the present application in a rejection under 35 U.S.C. § 102(e). Therefore, it is respectfully submitted that the rejection of the claims under 35

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<sup>1</sup> See for Example online URL Dictionary.com

U.S.C. § 102(e) should be withdrawn.

Notwithstanding the removal of the Bahar reference as an available prior-art reference and consequently, that cannot be cited against the present application, Applicants wish to further point out below some clear distinguishing features of the presently claimed invention over any cited reference that is similar to the Bahar reference.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 17 recites, *inter alia*:

**transmitting a document from a systems device through a two way communications system to an address of a presentation device;**

**... as a first step in accessing a copy of said document, inputting at said presentation device, identifying data indicative of the identification of a party accessing the document; ...**

**as a second step in accessing a copy of said document, without authentication and directly responsive to receiving said identifying data, producing a print command;**

**... as a fourth step, producing a record of said identifying data used to produce said print command, and transmitting said record.** (emphasis added).

The Bahar reference discloses an email system, where a user account is provided to a registered user and an email address is associated with the user account. Bahar, Para. 0026. An email address is defined in Bahar as "both the address label of the e-mail/user account, and the e-mail/user account itself." "[I]ncoming email directed to a particular email address ... are logged and saved under the designated user account, which is accessible by password or confidentiality code entry" from any computer anywhere. Bahar, Para. 0026. To gain access to their designated account, the user connects to the Internet via an ISP and logs into a user account by entering a password, confidential access code or alternate means of identity, such as fingerprint, DNA, etc. Bahar, Paras. 0026 & 0029. The password and other methods of identification are utilized to ensure that a potential user is authorized to receive and view the email. Bahar, Para. 0041. Therefore, unlike the present invention, Bahar teaches sending a document to a specific device based on authentication and e-mailing

a user. In contrast, the present invention recites “print the document based on the identification of a party accessing the document at a given device.”

Furthermore, unlike the present invention, in Bahar, an authorization must occur before the email is accessible by the registered user or anyone else. The present invention only requires “inputting at said presentation device, identifying data indicative of the identification of a party accessing the document”. The present invention does not require any form of authorization, as is clear in the language of amended claim 17: “...as a second step in accessing a copy of said document, without authentication and directly responsive to receiving said identifying data, producing a print command...”

Additionally, as stated in paragraph 0026 of Bahar, “while the registered user is the original entity having authorized access to the email address, it is the accessing party who gains access to the email address/account, whether authorized or unauthorized, and triggers an access event...” (emphasis added). In other words, once a registered user provides his password, and the password is authorized by the system, access to the account is then opened on the registered user’s computer. As long as the account is open, any user can then access documents in the registered user’s account by using the registered user’s computer terminal **without providing identification information**.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Bahar.<sup>2</sup> The elements in independent claims 17, 22, and 24 (at least “transmitting a document to... an address of a presentation device” and “identifying data indicative of the identification of a party accessing the document... and... accessing a copy of said document, without authentication”) of the instant application are not taught or disclosed by Bahar, and, therefore, Bahar does not anticipate the present invention. The dependent claims are believed to be patentable

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<sup>2</sup> See MPEP §2131 (Emphasis Added) “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.”

as well because they all are ultimately dependent on either claim 17, 22 or claim 24. Accordingly, the present invention distinguishes over Bahar for at least this reason. The Applicants respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome.

(2-3) Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) in view of DiGiorgio et al. (U.S. Pat. No. 6,418,420). The Applicants have cancelled claims 12-14 without prejudice, rendering moot the Examiner's rejection of these claims.

The Examiner rejected claims 11 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) and DiGiorgio et al. (U.S. Pat. No. 6,418,420) in view of Bell (U.S. Pat. No. 6,600,902).

For the reasons stated in the previous section of this Amendment entitled "(1) Rejection under 35 U.S.C. § 102(e) Bahar", it is respectfully submitted that the present invention overcomes the Examiner's rejections with reference to the Bahar reference. The Applicants have cancelled claim 11 without prejudice, rendering moot the Examiner's rejection of this claim.

DiGiorgio et al. teaches secure token devices used for **authentication**. See column 2, lines 64-65, column 4, lines 1-3 & 56-58 of DiGiorgio et al. The secure token device serves as a secure purse mechanism for distributed budgeting and accounting within a closed economy. Column 4, lines 54-56. The secure token device, however, also serves as a base **authentication authorization** mechanism. Column 4, lines 56-58. Based upon identification information contained within the secure token device, the system determines **whether the holder is permitted to access the resource or not**. Column 3, lines 9-11. DiGiorgio et al. clearly does not teach or suggest the claimed invention as recited in the present independent claims, and in all dependent claims depending therefrom, respectively.

The Bell reference was cited as a combination with the Bahar and DiGiorgio et al references, to add to Bahar's teaching of notification of remote output. Bell teaches a system in which wireless links are authorized through matching personal identification codes. See column 3, lines 12-15 of Bell. Bell "[sets] up a first short-range wireless link between a first and a second wireless station, while entering a first personal identification code in said first wireless station and a second identification code in said second wireless station, and **only establishing a data connection through said first short-range wireless link between said first and second wireless stations when said first and second personal identification codes are the same.**" Column 3, lines 39-46. Bell clearly does not teach or suggest the claimed invention as recited in the present independent claims, and in all dependent claims depending therefrom, respectively.

As the Examiner correctly states on page 12 of the Office Action "*Bahar does not disclose a portable device for storing said identifying data wherein said portable device is a smart card or Java Ring*" and goes on to combine DiGiorgio et al.<sup>3</sup> On page 13 of the Office Action, the Examiner goes on to say that "*Bahar and DiGiorgio does not expressly disclose wherein said identifying data is in a pre-determined Vcard format*" and goes on to combine Bell.<sup>2</sup> The Examiner recites 35 U.S.C. §103(a) for both statements.

Moreover, The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such as, proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the prior art reference, such a proposed modification is not proper

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<sup>3</sup> Applicant makes no statement whether such combination is even proper.

and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Bahar, DiGiorgio, and Bell is user **authentication**. In contrast the intent and purpose of the present invention is user **identification**. The present invention eliminate the need to verify i.e. compare the user information with user information previously stored such as a userid and password, biometric data such as a fingerprint or a security card. This combination, as suggested by the Examiner, destroys the intent and purpose of Bahar taken alone and/or in view of DiGiorgio and Bell's teaching of **authentication**. Accordingly, the present invention is distinguishable over Bahar taken alone and/or in view of DiGiorgio and/or Bell for this reason as well.

The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." Bahar taken alone and/or in view of DiGiorgio et al. and Bell simply does not teach or suggest the limitations of independent claim 17 (and newly added independent claim 24 which recites the identical limitations).

Continuing further, when there is no suggestion or teaching in the prior art for that disclosed in the application, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). It is accordingly believed to be clear that Bahar, whether taken alone or in any combination with DiGiorgio et al. and Bell does not suggest, teach, nor mention transmitting a document from a systems device to **an address of a presentation device**; inputting at the presentation device, identifying data indicative of the identification of a party accessing the document and accessing a copy of the document, **without authentication** and directly responsive to receiving said identifying data, as stated in independent claims 17, 22, and 24 of the instant application. Claims 17, 22, and 24 are therefore believed to be patentable over

the art. Since dependent claims contain all the limitations of the independent claims, dependent claim 19 is believed to be patentable as well, and the Examiner's rejection should be withdrawn.

### CONCLUSION

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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